

REMARKS

Claims 1 through 20 are pending in this application. Claims 11 and 15 have been amended by this Amendment so as to more clearly define the invention disclosed in this application. New claim 20 has been added.

Applicant notes that Paper No. 3 was apparently issued twice. In the later issue, paragraphs 1 through 9 of the Examiner's comments were omitted, and the Examiner's comments began with page 2, paragraph 10. Applicant's undersigned attorney assumes that this was the Examiner's intention, and that some intervening correspondence either removed the rejections or remedied the issues. Despite this however, Applicant has amended claims 11 and 15 to remove the basis for the rejection.

Claims 11 and 15 were rejected under the second paragraph of 35 U.S.C. §112 as being possibly indefinite. Claim 11 was amended to substitute "throat" for "junction therebetween" while claim 15 was amended to delete the "opening" and to substitute "an exterior surface oriented to bear a device providing a visual display of information attached thereto." By way of explanation, such a visual device could be anything from a symbol where a discrete electronic clock, thermometer, page counter or calender that might be mounted upon the exterior surface of Applicant's clip marker. These are standard, well known component, and there is no need to amend the drawings to incorporate such details. If the Examiner persists in requiring amendment of the drawings however, the Examiner is requested to defer the requirement for amendment until indication of allowable subject matter.

Claim 15 was also rejected under the first paragraph of §112. The forgoing explanation clarifies and removes the basis for their rejection. Its withdrawal is therefore requested.

Claims 1 through 6 and 9 were rejected under 35 U. S. C §102(b) as anticipated by Martin U.S. 2,448,611.

Martin '611 discloses a long sheet of material such as cloth or paper, folded at a center 16 to provide two normally open and spaced apart legs of equal length, each bearing a magnet 10. The very ends of the legs bearing the magnets or covered by the folded ends of the legs. A second, shorter strip 18 forms an arch that strengthens the equal length of the legs, but obscures the junction 16 of the central fold.

In contradistinction, Applicant discloses and claims a separate construction for a magnetic clip marker that provides a structure that may be manufactured with a normally closed orientation of the opposite legs, and which may be fabricated with an equal length of the legs, thereby assuring both that the opposite legs will remain in their normally closed position after a page of a book has been inserted between the legs and, through the use of the unequal length, facilitating insertion of the page of the book. As defined by claims 1 through 19, Applicant provides a structure with both a base portion and the clip portion, with the "clip portion" defined as "overlapping said base portion to define a throat therebetween and structurally arranged to receive a page of a book between said base and said clip portion." In contradiction, the shorter strip 18 of Martin deleteriously prevents the insertion of the page of the book all the way to the throat, that is the "clip portion" of claim 1. This limits and hinders the use of the clip as a line marker, as is described in Applicant's specification. Consequently, there is no anticipation.

Claims 6, 7 and 10 were separately rejected under 35 U.S.C. §103(a) as rendered obvious by Martin '611. As demonstrated by the foregoing paragraphs, Martin '611 fails to provide *prima facie* showing of obviousness in view of the omission of the features defined by the pending claims, and in view of the noted advantages flowing from those differences. Accordingly, there is no basis for maintaining this rejection.

Claims 11 through 14 were separately rejected under 35 U.S.C. §103(a) as rendered obvious over proposed combination of Martin '611 modified according to Johnson '777 to provide a structure "with at least one of edges of the wall members is traversed. Applicant respectfully traverses this rejection for the following reasons:

First, there is no basis for making the proposed combination. Specifically, Figure 21 necessarily depends upon a discreet element, namely indicator B, which is in turn mounted upon track 17 of mounting strip A. Utterly absent from the Examiner's proposed combination is any explanation of how material 6 of Martin '611 might be modified to provide track 17. Absent of this, there is no basis for combining Figure 21 with material 6 of primary reference.

Second, the proposed combination would still include shorter strip 18 that obscures the throat and clip of the marker provided by the primary reference. It is this feature that advantageously enables Applicant's structure to serve as "line marker" as explained on page 4, line 5 of the original specification. The significance of this feature is emphasized by Johnson '777 itself; however, the combination may not be made and if made, would impermissibly destroy the required fabrication of the primary reference. Accordingly, withdrawal of this rejection is required.

Claim 15 is rejected under 35 U.S.C. §103(a) as rendered obvious by a proposed combination

of Martin '611 and Schwartz '043. Applicant respectfully traverses this rejection for the following reasons.

Again, there is no basis for making this proposed combination; the Examiner has given no thought to incorporation of the hollow tube adapter illustrated in Figure 26 of Schwartz '043 into the structure of the primary reference. Literally, the Examiner's proposed combination includes some undisclosed cooperation of Post-It notes and an electronic computer. *See* Schwartz at column 4, lines 1-10. How is this combination to be made? Even if made, it does not meet parent claim 1.

Secondly, the Examiner has no basis for modifying the primary reference to incorporate the hollow tube structure of Schwartz '043, except an impermissible picking and choosing of the elements of the art in light provided by the Application alone. The mere fact that the Examiner is able to pick and choose from numerous prior art references is evidence nothing, except the Examiner's willingness to ignore the requirements of Section 103 that the subject matter of the pending claims in their entirety be considered. Moreover, all inventions are constructed from old components; it is the definition of these combinations of old components provided by the claims that must be considered, not the ability of the Examiner to identify each separate and old component comprising the claims.

Furthermore, the Examiner's proposed combination fails to remedy the deficiencies in the primary reference noted earlier herein. Accordingly, withdrawal of this rejection and allowance of claim 15 is required.

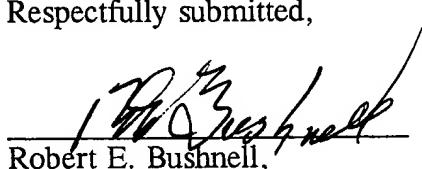
In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is

requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A response to the Office action (Paper No. 3) issued on the 10th of October 2000 is originally due on 10 January 2001. Applicant hereby requests to extend the time for responding for three months to and through 10 April 2001. A Petition for Extension of Time is being filed concurrently.

A fee \$250.00 for three month extension of time is incurred by this filing (Applicant paid \$195.00 on February 8, 2001 accompanied by a Petition for two month extension of time.). Applicant's check drawn to the order of Commissioner in the amount of \$250.00 is attached (#39421). Should the check become lost, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE SPECIFICATION**

On page 1, paragraph 4, please replace paragraph 4 in its entirety with the following:

[0004] This type of [bookmarks] bookmark present numerous disadvantages. One of them is that, if several pages are intended to be marked by using several bookmarks, upon closing the book, the bookmarks will remain overlapped, marking the access to the different marked pages difficult.

On page 5, paragraph 17, please replace paragraph 17 in its entirety with the following:

[0017] The laminar walls may also serve as support for electronic devices with displays, such as flat clocks, thermometers, or calculators.

On pages 5-6, paragraph 20, please replace paragraph 20 in its entirety with the following:

[0020] Figure 2 is a front view of the bookmark already introduced on the edge of the page. It can be appreciated the surface of the longer laminar wall may serve to apply advertising or ornamental prints. It can be seen how the signaling tab and the upper longitudinal edge which marks the line jut out.

On page 6, paragraph 24, please replace paragraph 24 in its entirety with the following:

[0024] Figure 5 is a longitudinal cut view of the bookmark as viewed along sectional line V-V in Figure 3 allowing the observation of the inner aspect of the shorter laminar wall.

On page 7, paragraph 39, please replace paragraph 39 in its entirety with the following:

[0039] (11) Recess from which the tab is formed (7).

Between pages 7 and 8, please replace paragraph 41 in its entirety with the following:

[0041] figure 2 shows the longer laminar wall (5) whose large surface (5') can be used to apply graphic prints such as advertising messages or ornaments and whose longitudinal edge (100 is a line marking means. At the joint (7) between both walls (2) (5) a tab (7') juts out outstanding noticeably from the edge (6') of the page (6).

On page 8, paragraph 45, please replace paragraph 45 in its entirety with the following:

[0045] In Figure 5, the cut shows the shorter laminar wall (2) which, in the inner part of the clip (1), has the first magnetic means fixed (3), above which there is the cover (9) (in this case, it is transparent). Recess (11) on the transverse edge results from the cut with which the tab is formed (7').

On page 9, please replace paragraphs 49 and 50 in their entirety with the followings:

[0049] When introducing the bookmark on the edge (6') of the page (6), the entrance of the latter (6) is facilitated by the presence of the cover (9). This is due to the fact that cover (9) facilitates the page sliding (6) and prevents the impingement between the edge (6') of the page (6) and the prominent edges (8) of the magnetic means (3) (4), as it can be observed in Figures 3, 3A and 5.

[0050] The joint (7) between the shorter and longer walls (2) (5) acts as the stop of the pages (6) admission into the clip (1). Therefore, the tab (7') is the element which outstands most from the pages (6) once the bookmark is placed, as can be seen in Figures 2, 3 and 4.

IN THE CLAIMS

Please amend claims 11 and 15 as follows (proposed new claim 20 is previously listed above):

1       11. (Amended) The magnetic clip marker in accordance with claim 9, wherein at least one  
2       of the edges of said pair of wall member is transverse to said [junction therebetween] throat to form  
3       a line signaling member on the page of the book.

1       15. (Amended) The magnetic clip marker in accordance with claim 1, wherein at least one  
2       of the external surfaces of the page marker opposite said throat [opening] includes an exterior surface  
3       oriented to bear a device providing a visual display of information [display device] attached thereto.